

REMARKS

Claims 1-14 and 17-23 were previously pending in this patent application. Claims 1-14 and 17-23 stand rejected. Further examination and reconsideration in view of the claims, remarks, and arguments set forth below is respectfully requested.

35 U.S.C. Section 103(a) Rejections

Claims 1-14 and 17-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Marik, U.S. Patent No. 5,903,718 (hereafter Marik), in view of Grunert, U.S. Patent No. 6,366,878 (hereafter Grunert), and further in view of Dey, U.S. Patent No. 5,438,672 (hereafter Dey). These rejections are respectfully traversed.

It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

Focusing on Independent Claim 1, it is respectfully submitted that the combination of Marik, Grunert, and Dey is improper. In the section "Response to Arguments" at page 7 of prior Office Action mailed 1/22/2007, it was stated, "the

object of Marik's invention is to enhance in-circuit emulation by using fewer components,” (internal emphasis) and Col. 2 lines 14-19 of Marik was cited. Marik actually teaches away from the current claims. Col. 4 lines 9-14 of Marik says, “The present invention contains built-in 8031 software used to debug 8031 based systems without the need for an in-circuit emulator and its associated hardware. A developer can actually use the target system to debug itself with the present invention target system bootstrap ROM code and Host Debugger Application program,” (emphasis added).

In particular, Independent claim 1 recites in part: “An in-circuit emulator system breakpoint control...” Further, Independent Claims 7 and 14 each recite: “A method of establishing a breakpoint in a microcontroller in an in-circuit emulator system.”

As discussed above, the combination of Marik, Grunert, and Dey is improper because Marik teaches away from combining the cited references. Therefore, it is respectfully submitted that Independent Claim 1 and the other Independent Claims 7 and 14 are patentable over the combination of Marik, Grunert, and Dey and is in condition for allowance.

Dependent Claims 2-6 and 21 are dependent on allowable Independent Claim 1, which is allowable over the combination of Marik, Grunert, and Dey. Hence, it is respectfully submitted that Dependent Claims 2-6 and 21 are

patentable over the combination of Marik, Grunert, and Dey for the reasons discussed above.

Dependent Claims 8-13 and 22 and Dependent Claims 17-20 and 23 are dependent on allowable Independent Claims 7 and 14, respectively, which are allowable over the combination of Marik, Grunert, and Dey. Hence, it is respectfully submitted that Dependent Claims 8-13 and 22 and Dependent Claims 17-20 and 23 are patentable over the combination of Marik, Grunert, and Dey for the reasons discussed above.

CONCLUSION

It is respectfully submitted that the above claims, arguments and remarks overcome all rejections and objections. All remaining claims (Claims 1-14 and 17-23) are neither anticipated nor obvious in view of the cited references. For at least the above-presented reasons, it is respectfully submitted that all remaining claims (Claims 1-14 and 17-23) are in condition for allowance.

The Examiner is urged to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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